

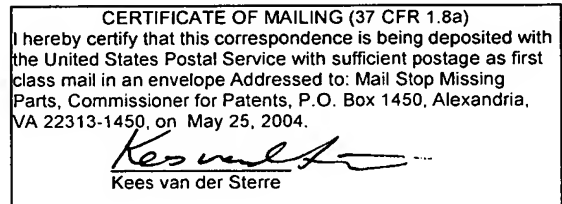


PATENT
SP03-159

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Jeffrey M. Amsden, et al.)	Petition and Declaration of Facts
		:	Under
)	37 CFR §1.47(a)
Serial No.:	10/750,472	:	
)	Group Art Unit: 1764
Filing Date:	December 31, 2003	:	
)	Examiner: TBD
Title:	Multi-Tubular Reactors With	:	
	Monolithic Catalysts)	

Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450



Sir:

Your Petitioner Corning Incorporated, having an ownership interest in the invention described and claimed in the above-entitled U.S. Patent Application, hereby petitions the Commissioner to accept the filing of the above-entitled application by co-inventors Jeffrey M. Amsden, Achim K. Heibel, and Neil E. Partridge, for themselves and on behalf of non-signing co-inventor Gildas Boulc'h of Avon, France, to preserve the rights of all parties in this case.

Declaration and Assignment documents executed by co-inventors Amsden, Heibel and Partridge, the latter evidencing Corning's ownership interest in this application, are being submitted herewith.

The bases for Petitioner's request for relief in this case are (i) the refusal of co-inventor Gildas Boulc'h to join in the present application for patent, and (ii) the ownership interest of Corning Incorporated in securing patent protection for the claimed invention.

The Commissioner is hereby authorized to charge the fee due under 37 C.F.R. §1.17(h) for the filing of this Petition to Deposit Account No. 03-3325 of Corning Incorporated.

The facts recited below establish the refusal of Mr. Boulc'h to join in the application after being given full knowledge thereof and a number of opportunities to do so. Corning respectfully submits that the granting of this Petition is necessary to preserve the rights of the parties and to prevent the irreparable damage that would result if the signing inventors, for themselves and on behalf of the non-signing inventor, were denied the right to seek patent protection for the claimed invention.

Declaration of Facts

The following facts, known to the Petitioner's undersigned attorney or attested to by him on information and belief, are relied on in support of this Petition:

1. Co-inventor Gildas Boulc'h joined Corning subsidiary Corning S.A. as an engineer in its Avon, France Research Center on March 16, 1992, and ended his employment with Corning on 31 December 2001. (Exhibit 1 attached)

2. Mr. Boulc'h's employment contract did not include a written obligation to assign his inventions to Corning, but under French law: Article 611.7 of the Intellectual Property Code, inventions made by salaried persons under employment agreements that include inventive activity automatically belong to the employer.

3. On November 20, 2003, a set of application papers including an inventor's declaration and assignment of the patent application to Corning Incorporated was forwarded from the office of the undersigned at Corning, New York to Ms. Josette Locicero of the Avon Research Center (Centre Européen de Recherche & Technologie) at Avon France, for the purpose of obtaining Mr. Boulc'h's signature on the papers. (Exhibit 2 attached)

4. In due course those papers were forwarded from the Center to Mr. Boulc'h, whose his last known address as of that date was as follows:

Mr. Gildas Boulc'h
56, Rue du Vieux Rû
77210 Avon
FRANCE

5. On December 3, 2003, in an electronic message to the undersigned and to Dr. Daniel Ricoult of Corning Incorporated, Mr. Boulc'h acknowledged receipt of the patent application papers. However, he declined to execute them as written, for the

reason that the content was unsuitable for a former Corning employee. (Exhibit 3 attached).

6. On or about January 20, 2004, Dr. Serge Marsaud, an employee of Corning SA at the Avon Research Center and former associate of Mr. Boulc'h, conducted a telephone discussion with Mr. Boulc'h during which the latter confirmed he was not willing to sign the papers because he was no longer a current Corning employee, and because he was uncertain as to the value received or to be received (by him) for the execution of the Assignment. (Exhibit 4 attached).

7. On February 11, 2004, Dr. Marsaud transmitted a modified assignment document drafted by the undersigned attorney to Mr. Boulc'h, the form of which had been changed to reflect Mr. Boulc'h's status as a former Corning employee who had received salaried compensation in return for the assignment of his employment inventions. (Exhibit 5 attached).

8. On February 12, 2004, Dr. Marsaud telephoned Mr. Boulc'h to inquire whether the new assignment was satisfactory. In the course of that conversation Mr. Boulc'h acknowledged receipt of the new assignment and indicated that its meaning was clear, but he further indicated that he would "not sign anything" because there was no "financial compensation proposed". (Exhibit 6 attached).

9. On February 16, 2004, Mr. Boulc'h transmitted an e-mail message to Dr. Daniel Ricoult of Corning, with a request that it be forwarded to the undersigned attorney. In that e-mail Mr. Boulc'h reiterated that he would continue to refuse to sign the application papers under the circumstances as they then existed. (Exhibit 7 attached).

10. On March 2, 2004, the undersigned attorney transmitted a letter directly to Mr. Boulc'h by e-mail, informing him that the patent application had been filed in his name and of the particulars of that application. Also included was a 30-day offer to compensate Mr. Boulc'h for his time in reviewing and executing the application papers. In an e-mail reply to the undersigned attorney dated March 5, 2004, Mr. Boulc'h acknowledged receipt of the letter and the offer. However, at that time, and continuing up until the present date, Mr. Boulc'h has persisted in his refusal to execute the application.

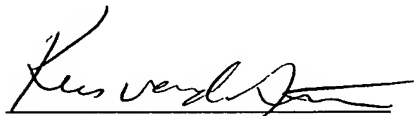
Based on the foregoing facts, your Petitioner respectfully submits that the refusal of Mr. Boulc'h to execute documents pertaining to the above-entitled application is clear and continuing, and therefore that this Petition Under 37 CFR §1.47(a) to permit the filing and prosecution of this application on behalf of Mr. Boulc'h by the signing co-inventors Messrs. Amsden, Heibel and Partridge should be granted.

Petitioner requests that any questions or comments relating to this Petition and Declaration be directed to Petitioner's undersigned attorney.

Petitioner's undersigned attorney hereby declares that all statements of fact made herein of his own knowledge are true, and that all statements made on information and belief are believed to be true, and further that those statements are made with the knowledge that willful false statements are the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

Respectfully submitted,

Date: May 25, 2004



Kees van der Sterre
Attorney for Assignee
Reg. No. 25,938
Corning Incorporated
SP-TI-03
Corning, NY 14831
(607) 974-3294

Attachments: Exhibits 1 – 7

Corning S.A.

Centre Européen de
Recherche de Fontainebleau
7bis, avenue de Valvins
B.P. n° 3
F - 77210 Avon

☎ 33(0) 1 64 69 74 00
☎ 33(0) 1 64 69 74 01
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Exhibit 1**CERTIFICAT DE TRAVAIL**

CORNING
Discovering Beyond Imagination

Je soussigné, Christian FABRE, Directeur Ressources Humaines du Centre Européen de Recherche de la Société CORNING S.A., 7bis, Avenue de Valvins à AVON (77210) certifie que

Monsieur Gildas BOULC'H

a été employé dans notre Société du 16 Mars 1992 au 31 Décembre 2001 en qualité d'Ingénieur, Coefficient 450, Catégorie 8 b.

Fait à Avon, le 2 janvier 2002



Christian FABRE

To: Josette Locicero

Date: November 20, 2003

From: Christine Watters

IP Department

SP-TI-3

watterscf@corning.com

BY DHL

Re: Inventor Signature Required

Enclosed are the patent application documents that require Gildas Boulc'h's signature.

SP03-159 Multi-Tubular Reactors with Monolithic Catalysts

-
- 1 copy Inventor Statement (need to answer questions 1-4)
- 1 copy Declaration in Original Application
- 1 copy Declaration attached to application
- 2 copies Assignment (please note the city needs to be filled in at the top of page 2 and inventor signature needs to be witnessed)
- 1 copy Brazilian paper
- 1 each Taiwan Oath & Assignment
- 2 copies Indonesian papers
- 1 copy China assignment
- 1 copy India Form 1
- 1 copy Republic of South Africa Assignment

Also enclosed is a copy of the patent application and a \$2 certificate for the inventor. Once the papers have been signed, please return the documents to me by express mail.

I appreciate your assistance with this matter. If you have any questions, please let me know.

-----Original Message-----

From: Gildas BOULC'H [mailto:boulchg@freesurf.fr]

Sent: Wednesday, December 03, 2003 11:02 AM

To: ricoultd@corning.com

Cc: vandersterrek@corning.com

Subject: About SP03-159. Forward to Kees van der Sterre. AW

Dear Sir,

I recently received a list of documents concerning the above mentioned patent. Though I agree with the principle of signing them, it appears that the paper entitled "assignment" and its content is more suited to a Corning Incorporated employee.

Yours faithfully,

Gildas BOULC'H

boulchg@freesurf.fr

Exhibit 4

From: Marsaud, Serge
Sent: Tuesday, January 20, 2004 1:27 PM
To: Vandersterre, Kees
Cc: Heibel, Achim K; Locicero, Josette
Subject: RE: About SP03-159

I have finally talked to Gildas.

He claims having some problems of understanding since his english is not perfect and he is not a lawyer.

The paper which represents a problem for him is the one called "Assignment"

He told me not to be comfortable to sign a paper the terms of which seems to consider he is an employee of Corning while he is not any more. He is worried not understanding what really mean the words "for value received".

I proposed him to be called directly by you to get explanations but he refused it.... He prefers receiving a mail.

So, what I proposed : I'll get a model of the so called assignment (hope Josette has one or if not, send me a blank file). I'll call him again with that in hands, and see if I can answer his questions. If not, I will precisely transcribe those questions and Gildas, at this time will expect to have an answer from you, kees, by mail (boulchg@freesurf.fr). Thus, I will call him back tomorrow...

Not an easy communication....

Hoping to be successful,

Serge G Marsaud Dr.
(33) 1 64 69 76 29
Assistant: Dominique Eudeline (eudelined@corning.com)
(33) 1 64 69 73 11

-----Original Message-----

From: Vandersterre, Kees
Sent: Tuesday, January 20, 2004 7:41 PM
To: Marsaud, Serge
Cc: Locicero, Josette
Subject: RE: About SP03-159

Serge:

The attached is a modified assignment form which we would accept from Gildas if he would prefer it. We need him to sign duplicate (2) prints of the document.

I have made it clear in this version that he is not signing as a current employee but only as a former employee of Corning France. Further, I have detailed the value received, which is the compensation he received as an employee of Corning during the period when the invention was made.

I hope this will address his concerns but if he has further questions I will try to answer them. In either case we ask that he sign at least the Declaration included with the other papers, attesting to his inventorship, and that he do that and return the papers to Josette as soon as possible.

Again I thank you for your help.

Kees v. Patent Dept.

<< Fichier: boulc'h.assignment.doc>>

-----Original Message-----

From: Marsaud, Serge
Sent: Thursday, February 12, 2004 1:28 PM
To: Vandersterre, Kees
Subject: RE: About SP03-159

I have forwarded your new version...

I left too a voice message on Gildas phone, but in fact he doesn't call himself.

He was not home until late yesterday and presently (7:25 pm) he still doesn't answer. I will try again from home to night.

Serge G Marsaud Dr.

(33) 1 64 69 76 29

Assistant: Dominique Eudeline (eudelined@corning.com)

(33) 1 64 69 73 11

Exhibit 6

-----Original Message-----

From: Marsaud, Serge
Sent: Friday, February 13, 2004 1:51 PM
To: Vandersterre, Kees
Subject: RE: About SP03-159

Kees,

Yesterday night call was the tougher one....

In a few words, (Gildas contribution in bold)...

"The new document submitted is clear but it doesn't change anything bottom line. - What do you mean ? - I mean it is not a win-win document and that there is no financial compensation proposed. I prefer to keep for myself the benefit of my invention - Yes but you must realize that the ID was written while you were salaried, with an inventive dimension included in your mission and using the equipment and means of your employer.... - I don't want to hear that. I expect to be proposed a transaction, and since I am a scientist, and not a lawyer, if it occurs, I'll design a lawyer to discuss with you. Without that I will not sign anything."

It is not the first time I see Gildas with a very non rational behavior. That occurred several times at work, in a quite characterized way, and accounted for the reasons we decided not to go farther with him, few years ago...

I don't know what I can do after that. Let me know any way.

Serge G Marsaud Dr.
(33) 1 64 69 76 29
Assistant: Dominique Eudeline (eudelined@corning.com)
(33) 1 64 69 73 11

-----Original Message-----

From: Gildas BOULC'H [<mailto:boulchg@freesurf.fr>]

Sent: Monday, February 16, 2004 9:02 AM

To: RicoultD@corning.com

Subject: ABOUT SP03-159. GB for DR. FW TO KVDS.AW.Kenavo

Kees/Daniel,

Beeing given the attitude of Dr Marsaud on the telephone, I inform you that I will not sign the document.

Should a gentlemen' s agreement be found, this will now be by other means.

Best Regards,

Gildas BOULC'H
boulchg@freesurf.fr